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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,391	01/02/2001	Kee-hwan Lee	Q62029	7508

7590 09/22/2004

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EXAMINER
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HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/751,391

Applicant(s)

LEE ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed on June 9, 2004.

Claim 21 has been canceled. Claims 1-20 and 22-42 are pending and will be considered for examination. Applicants' amendments to claims 1 and 4 are sufficient to overcome the Examiner's objection. The objection to claims 1 and 4 is hereby withdrawn.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20, and 22-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The steps of these claims can be performed by hand and do not require any technology whatsoever. Although the claims recite technology in the preamble, the Examiner notes that the preamble is not given any patentable weight because the body of the claims do not depend on the preamble for completeness. *"A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone."* See *In re Hirao*, 535

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*F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88*

*USPQ 478, 481 (CCPA 1951).* Finally, claims 4, 10, and 18 recite the term "database"

in the body of the claims. However, the use of this term does not constitute a

technological recitation since a database can be a physical database (e.g. a folder in a

cabinet). For these reasons, claims 1-20 and 22-27 are deemed to be not within the

technological arts. *"The claimed invention must utilize technology in a non-trivial*

*manner" (Ex parte Bowman, 61 USPQ2d, 1665, 1671 (Bd. Pat. App. & Inter. 2001)).*

Although Bowman is not precedential, it has been cited for its analysis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5, 8-13, 16, 17, and 28-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Postrel (US Patent 6,594,640 B1).**

Referring to claims 1-5, 8-13, 16, 17, and 28-42, Postrel teaches a points trading service, the method and apparatus comprising:

- receiving through a telecommunications network a request for trading points a customer gets from a member shop (column 6, lines 13-52);

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- carrying out a transaction corresponding to the request for trading points with at least one other customer (column 1, lines 22-26; column 5, lines 61-67);
- wherein the trading points are airline mileage points (column 1, lines 22-26);
- calculating a balance of the customer's remaining trading points after the customer uses the trading points to purchase a good or service (column 7, lines 31-3);
- collecting information regarding a customer's trading points portfolio from member shops and storing the information in a customer database (column 6, lines 30-33; Figure 4);
- changing the customer's trading points into a cash equivalent and processing the customer's trading points according to the resulting cash equivalent (column 6, lines 38-52);
- a customer and transaction database for storing information on the points trade request sent from the customer and a result of processing transactions (Figure 5, Item "54");
- a shopping mall management unit for processing cyber shopping, and providing trading points in proportion to a good purchased and a service for buying goods with the trading points (column 1, line 14 – column 3, line 55; Figure 1).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6, 7, 14, 15, and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (US Patent 6,594,640 B1).**

Referring to claims 6, 7, 14, 15, and 18-27, Postrel does not teach updating a customer database and a transaction database according to a result from the trading points transaction, and sending the result to the corresponding member shop. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this step into the method and apparatus of the Postrel in order to create a record of the transaction and to notify the member shop of the transaction so that it could update its database. This would serve as a "paper trail" to document the transaction in the event that a dispute occurred at a later time.

***Response to Arguments***

Applicants' arguments with respect to the Examiner's objection to claims 7, 9, 13, 15, 17, 23, 25-27, 33-35, 37, and 38 have been fully considered and are persuasive. The objection to these claims is hereby withdrawn.

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Applicants' arguments with respect to the Examiner's 102(e) rejection of claims 1-5, 8-13, 16, 17, and 28-42 and 103(a) rejection of claims 6, 7, 14, 15, and 18-27 have been fully considered but they are not persuasive. The Applicants have argued that Postrel fails to teach trading of points between customers of a member shop. The Examiner respectfully disagrees. Postrel teaches that points of a member shop can be traded. Postrel goes on to teach that users can purchase points traded in by other users (column 1, lines 20-26). The Examiner notes that the Applicants' claims do not state that the transaction occurs only between the customers. Furthermore, the claims do not state who or what is carrying out the transaction. However, the Applicants' specification teaches that the trading system buys points from one customer and sells them to another customer at an exchange rate that allows the system to generate revenue from the spread between the buying rate and the selling rate. (see specification page 7, lines 2-20). Clearly, the Applicants' trading system acts as an intermediary between two customers, and the term "exchange" is nothing more than buying points from one customer and selling them to another customer. For these reasons, the Examiner maintains the art rejection.

Applicant's arguments with respect to the Examiner's 103(a) rejection of claims 1, 2, and 4-7 over Weisul and Postrel and have been fully considered and are persuasive. This rejection is hereby withdrawn.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



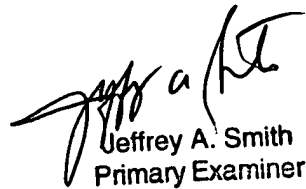
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

September 19, 2004



Jeffrey A. Smith  
Primary Examiner